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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,001	08/08/2001	Toru Matsumoto	WAK.094	1927

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EXAMINER

OLSEN, KAJ K

ART UNIT	PAPER NUMBER
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1753

DATE MAILED: 11/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/924,001

Applicant(s)

MATSUMOTO, TORU

Examiner

Kaj Olsen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,7,10,13,31,32 and 34 is/are rejected.
- 7) ☒ Claim(s) 3,5,6,8,9,11,12,14-30,33,35 and 36 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8/08.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Objections

1. Claim 31 is objected to because of the following informalities: The word "palace" should be --place--. Appropriate correction is required.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Dörr et al (USP 5,100,530) (hereafter "Dörr").
5. Dörr discloses an electrochemical sensor comprising a working electrode 1, a counter electrode 2 and a reference electrode 3 (see figures and abstract). Dörr further discloses a means for examining the reference electrode where the electric potential of the reference electrode is examined (col. 4, line 44 through col. 5, line 43).

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6. Claims 31 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Feldman et al (USP 6,299,757).

7. Feldman discloses an electrochemical sensor comprising a working electrode, a counter electrode, and at least two reference electrodes (col. 33, lines 31-67). With respect to one of the reference electrodes being a "spare electrode" that is to be used when the use of the reference electrode is stopped, that is only the intended use of the apparatus and the intended use need not be given further due consideration in determining patentability. Feldman also teaches the use of an immobilized enzyme layer (see col. 24, lines 18-44).

Claim Rejections - 35 USC § 103

8. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feldman in view of Dorr.

9. Feldman set forth all the limitations of claim 1 (see discussion above), but did not explicitly recite a means for examining the reference electrode. However, the previously recited Dorr already sets forth a means for examining the reference electrode, which allows one to determine if the reference electrode is functioning properly (see discussion above). It would have been obvious to one of ordinary skill in the art at the time the invention was being made to utilize the teaching of Dorr for the sensor of Feldman in order to ensure the reference electrode is functioning properly.

10. Claims 4, 7, 10, 13, 31, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dorr in view of Dunn et al (USP 5,766,432).

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11. Dorr set forth all the limitations of the claims, but did not explicitly recite the use of a spare electrode when the means for examining the reference electrode determines that the reference electrode was abnormal. Dunn teaches in an alternate sensor the provision of an extra (i.e. spare) reference electrode such that no time is lost in measurement in the event that the reference electrode is found to be abnormal (col. 2, lines 34-50). It would have been obvious to one of ordinary skill in the art at the time the invention was being made to utilize the teaching of Dunn for the sensor of Dorr in order to ensure minimal time is lost in the event that a reference electrode is found to be abnormal.

Allowable Subject Matter

12. Claims 3, 5, 6, 8, 9, 11, 12, 14-30, 33, 35, and 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. The following is a statement of reasons for the indication of allowable subject matter: With respect to claims 3 and 33, the prior art does not teach nor render obvious all the limitations of claims 2 and 32 and further comprising the use of the set forth diffusion limiting layer composition. With respect to claims 5, 6, 8, 9, 11, 12, 14, 15, 35, and 36, the prior art does not disclose all the limitations of claims 4, 7, 10, 13, or 34, and further comprising the presence of an immobilized enzyme on the working electrode. With respect to claims 16-30, the prior art does not disclose nor render obvious all the limitations of claim 1 and further comprising where the means for examining comprises the specified examining electrode.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kaj Olsen whose telephone number is (703) 305-0506. The examiner can normally be reached on Monday through Thursday from 7:00 AM-4:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Nam Nguyen, can be reached at (703) 308-3322.

When filing a fax in Group 1700, please indicate in the header "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of this application. This will expedite processing of your papers. The fax number for regular communications is (703) 305-3599 and the fax number for after-final communications is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read 'Kaj Olsen', with a stylized flourish extending from the end.

Kaj K. Olsen
Patent Examiner
AU 1753
November 2, 2003